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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,404	10/16/2001	Michiaki Yokoyama	1341.1112	3181
21171	7590	12/01/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			SHEIKH, ASFAND M	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/977,404	<b>Applicant(s)</b> YOKOYAMA ET AL.	
	<b>Examiner</b> Asfand M. Sheikh	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

In response to the Remarks/Arguments received on 27-July-2006: claims 1-5, 10, 11, and 12 are pending for examination. Claims 1-5, 10, and 11 have been amended. Claim 12 is new.

Please note that the Examiner for the pending application has changed. The Examiner is now Asfand M. Sheikh. The Examiner would like to note that the Group Art Unit has not changed.

The Examiner withdraws the previous U.S.C. § 112 rejection found in the previous office action.

The Examiner establishes new grounds of rejection for claims 15, 10, 11, and 12, thus the action has been made FINAL.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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2. Claims 1, 2, 5, 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullaney United States Patent Application Publication 2001/0037283 in view of Miglautsch United States Patent 6,993,489 and Perri, III et al. United States Patent Application Publication 2001/0020231 (hereinafter Perri).

As per claim 1, Mullaney discloses transmitting, to a first terminal at an existing customer of business, a first e-mail requesting an introduction of a new customer-to-be for the business to acquire new customers through a Web site, based on the information on the existing customer registered in a file (see at least, 0027-0030), transmitting a third e-mail requesting an introduction of another new customer-to-be for the business to the second terminal when identifying the new customer as another existing customer after checking a file (see at least, 0027-0030).

Mullaney fails to explicitly disclose registering the information on the existing customer to a second file when receiving an application from the existing customer, and identifying the existing customer as an introducer of a new customer; transmitting, to a first terminal a second email to be transferred to a second terminal of the new customer, the second

e-mail including information on the business; registering information on the new customer to a third file when the new customer places an order through the Web site according to the information on the business; wherein the information of the existing customer in the second file is checked with the information on the new customer in the third file when the order is received from the second terminal.

However Miglautsch discloses transmitting, to a first terminal a second email to be transferred to a second terminal of the new customer, the second e-mail including information on the business (see at least, Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Mullaney to include transmitting, to a first terminal a second email to be transferred to a second terminal of the new customer, the second e-mail including information on the business as taught by Miglautsch. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide messages tailored to personal interests and characteristics of the new customer in order to lead a more effective marketing method (see at least, col. 2, lines 9-26).

Mullaney fails to explicitly disclose registering the information on the existing customer to a second file when

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receiving an application from the existing customer, and identifying the existing customer as an introducer of a new customer; registering information on the new customer to a third file when the new customer places an order through the Web site according to the information on the business; wherein the information of the existing customer in the second file is checked with the information on the new customer in the third file when the order is received from the second terminal.

However Perri discloses registering the information on the existing customer to a file when receiving an application from the existing customer (see at least, 0073), and identifying the existing customer as an introducer of a new customer (see at least, 0073); registering information on the new customer to a file when the new customer places an order through the Web site according to the information on the business (see at least, 0058 and 0073); wherein the information of the existing customer in the file is checked with the information on the new customer in the file when the order is received from the second terminal (see at least, 0058 and 0073).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Mullaney to include registering the information on the existing customer to a file when receiving an application from

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the existing customer, and identifying the existing customer as an introducer of a new customer; registering information on the new customer to a file when the new customer places an order through the Web site according to the information on the business; wherein the information of the existing customer in the file is checked with the information on the new customer in the file when the order is received from the second terminal as taught by Perri. One of ordinary skill in the art would have been motivated to combine the teachings in order to properly identify and correlate referrers to their respective customers (see at least 0018).

**As per claim 2**, Mullaney fails to explicitly disclose further comprising providing an incentive to the existing customer when the new customer places an order through the Web site.

However Perri discloses further comprising providing an incentive to the existing customer when the new customer places an order through the Web site (see at least, Abstract, 0058 and 0073).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Mullaney to include further comprising providing an incentive

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to the existing customer when the new customer places an order through the Web site as taught by Perri. The motivation to combine is the same as claim 1, above.

**As per claim 5,** The Examiner notes the limitations of claim 5 are substantially similar to that of claim 1, and thus are rejected accordingly.

**As per claim 10, 11, and 12,** the Examiner notes the claims 10, 11, and 12 are substantially similar to that of claim 1, and thus are rejected accordingly.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mullaney United States Patent Application Publication 2001/0037283, Miglautsch United States Patent 6,993,489, and Perri, III et al. United States Patent Application Publication 2001/0020231 (hereinafter Perri) as applied to claim 1 above, and further in view of Huang et al. United States Patent Application 2003/0097361 (hereinafter Huang).

**As per claim 3,** the combination method of Mullaney, Miglautsch, and Perri fails to explicitly disclose wherein the



second e-mail is transferred to an e-mail address selected from an e-mail address book of the first terminal.

However Huang discloses wherein the second e-mail is transferred to an e-mail address selected from an e-mail address book of the a terminal (0074).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination method of Mullaney, Miglautsch, and Perri to include wherein the second e-mail is transferred to an e-mail address selected from an e-mail address book of the a terminal as taught by Huang. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide an easier way to locate and find contact information related to a customers acquaintances.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mullaney United States Patent Application Publication 2001/0037283, Miglautsch United States Patent 6,993,489, and Perri, III et al. United States Patent Application Publication 2001/0020231 (hereinafter Perri) as applied to claim 1 above, and further in view of Hare et al. United States Patent Application 20020046053 (hereinafter Hare).

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As per claim 4, the combination method of Mullaney, Miglautsch, and Perri discloses wherein the new customer places the order through a website (see at least, 0058 and 0073).

The combination method of Mullaney, Miglautsch, and Perri fails to explicitly disclose wherein the information about the existing customer is input at the second terminal.

However Hare discloses wherein the information about the existing customer is input at the second terminal by the new customer (see at least, 0029-0031).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination method of Mullaney, Miglautsch, and Perri to include wherein the information about the existing customer is input at the second terminal by the new customer as taught by Huang. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide the ability to correctly track the which customers are associated with new customers.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claim 1-5, 10, 11, and 12 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

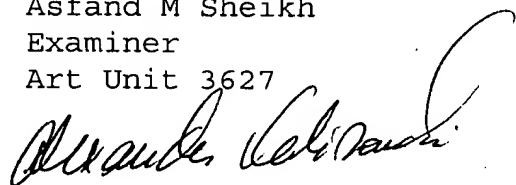
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 8a-4:30p.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Asfand M Sheikh  
Examiner  
Art Unit 3627



ams  
22-Nov-06

**ALEXANDER KALINOWSKI**  
**SUPERVISORY PATENT EXAMINER**